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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR       | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------------|---------------------|------------------|
| 10/786,733   | 02/25/2004  | Frederick James Diggle III | 030441              | 2744             |
| 38516 7590 01/27/2010<br>AT&T Legal Department - SZ<br>Attn: Patent Docketing<br>Room 2A-207<br>One AT&T Way<br>Bedminster, NJ 07921 |             |                            |                     |                  |
| EXAMINER<br>SHAKERI, HADI  |             |                            |                     |                  |
| ART UNIT PAPER NUMBER<br>3727  |             |                            |                     |                  |
| MAIL DATE DELIVERY MODE<br>01/27/2010 PAPER  |             |                            |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/786,733

**Applicant(s)**

DIGGLE ET AL.

**Examiner**

HADI SHAKERI

**Art Unit**

3727

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-11,13-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-10 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,11,13,19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “semi-circular end wall blending to the wider bottom floor” as recited in claims 1, 11 and 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

2. The amendments filed March 26, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "each groove having a terminus at which the open slot terminates at a semi-circular end wall blending to the wider bottom floor". There is no clear support for this language. There is no support for it in the original description. As to the original drawings, the Figure 5 and 5A drawings are so poor as originally filed that it is the examiner's position that these Figures do not provide support for this language. The terminus end (302?) is clearly arcuate when viewing Figure 5, however, there is no disclosure to support "a semi-circular" shape. Also, there no descriptions or drawings indicating as to how this semi-circular terminus blends into the wider (wider than 204?) bottom wall.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 3, 11, 13, 19 and 21-23 are finally rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. The claims have been amended to state for the very first time that "each groove having a terminus at which the open slot terminates at a semi-circular end wall blending to the wider bottom floor". There is no support in the description for this. The Figure 5 and 5A drawings are so poor as originally filed that it is the examiner's position that these Figures do not provide support for this language. The bottom wall appears to be straight particularly when viewing Figure 5, however, there is no disclosure to support "a semi-circular" shape. Also, there no descriptions or drawings indicating as to how this semi-circular terminus blends into the wider bottom wall.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

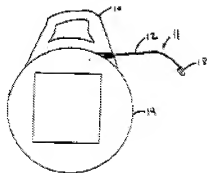
6. Claims 19 and 23 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "means for flexing the tape" in line 12, rendering the claim indefinite for double inclusion. It is unclear what means is being claimed, specification as originally filed, describes a means for flexing the tape defined by the circular, cylindrical shape of the tape, which is already recited in lines 1-3. The language as written implies other means for flexing the tape rendering the scope unascertainable. Rejection under 112, 1<sup>st</sup> paragraph for insufficient disclosure is not applied at this time, since it appears that the claim deficiencies are of clarity and not of enablement.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1, 3, 11, 13, 19 and 21-23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over White (2004/0180194).

White meets all of the limitations of claims 1, 11 and 19 including the narrative/functional language of claims 21-23, i.e., a steel wire fish tape **22 (12)** (circular) that is stored in a reel **14**; slots, grooves or holes that may be formed or cut into the fish tape so that wire or cable may be tied thereto or looped through (**paragraph 24**), except for the specific or particular shape and configuration of the grooves. It would have been an obvious matter of design to use a pair of opposed longitudinal dove tailed groove terminating at an arcuate surface (and/or a semi-circular surface) as a simple and efficient coupling means, since applicant has not disclosed that such shape solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any type of groove to "provide a mechanism for attaching a plurality of wire or capable engaging attachments to the end portion 51 of the fish tape 54", as stated in paragraph 31 of the instant application. It is further noted that dove-tail coupling means are known in the art, and using a pair of such grooves amounts to combining prior art elements according to known methods to yield predictable results; use of known technique to improve similar devices in the same way; applying a known technique to a known device ready for improvement to yield predictable results; and/or "Obvious to



try"-choosing from finite number of identified, predictable solutions, with a reasonable expectation of success.

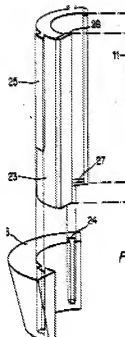
White as modified above meets all of the limitations of the claims 11 and 13, except for the particular sizes for the fish tape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention with regards to dimension or desired size in adapting the tool for a particular application, since such modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re* Rose, 105 USPQ 237 (CCPA 1955).

**9.** Claims 1, 3, 11, 13, 19 and 21-23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over White (2004/0180194) in view of Jansch (5,221,099).

White shows a fish tape **22** that may be fabricated of a steel wire stored in a reel and provides slots or grooves to facilitate connection to wire or cable engaging attachments, meeting the claimed invention, except for particular size and dove-tail grooves.

To make the outer diameter of the fish tape between .1875 and .375 is obvious to one having ordinary skill in the art at the time the invention was made since such modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re* Rose, 105 USPQ 237 (CCPA 1955).

Jansch teaches that an end of an elongate member may have a plurality of dovetail formations; e.g. See 25 in Figure 9 of Jansch. To provide on the end of the elongate member fish tape of White a plurality of dovetail formations would have been obvious in view of the Jansch disclosure. One skilled in the art would have been motivated to do this in order to facilitate a convenient and simple means for coupling the elongate fish tape to an object to be gripped by the fish tape. To provide dovetail grooves on the fish tape instead of formations would be no more than an obvious reversal of parts.



Further, whether the base of the groove semi-circular or slightly curved would be of immaterial difference and to make the base of the groove slightly curved would have been no more than an obvious matter of design choice absent a showing of criticality for this feature.

### **Conclusion**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Response to Arguments***

11. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 25, 2010

/Hadi Shakeri/  
Primary Examiner, Art Unit 3727